

REMARKS

Claims 1 to 11, are pending in this application; of which, claim 1 is the independent claim. Favorable reconsideration and further examination are respectfully requested.

Initially, Applicants thank the Examiner and the Examiner's Supervisor for conducting a teleconference on Tuesday, June 20, 2006. The Examiner's Supervisor observed that the amendments to the specification in the previous office action response were incorrect, and he recommended that Applicants resubmit them in this office action. In addition, the Examiner's supervisor agreed that Applicants' arguments detailed below overcome the §103 rejection.

Claims 1 to 11 were rejected under 35 U.S.C. § 103(a) as being obvious over Richards-Kortum et al. (U.S. Patent Number 6,187,289) in view of Yamamoto (U.S. Patent Number 4,395,398), Prevender (U.S. Patent Number 6,652,840), Klaveness et al. (U.S. Patent Number 6,159,445) and Rajadhyaksha et al. (J. Investigative Dermatology 113: 293- 303, 1999).

The Examiner has indicated that in the office action that a "contrasting solution comprising an AlCl solution" as recited in claim 1 does not preclude adding other agents to the acetic acid in Richards-Kortum (see page 5 of the Office Action). Applicants respectfully disagree. The AlCl is used as a contrasting agent. Furthermore, there is nothing in Richards-Kortum to disclose or suggest adding AlCl to the acetic acid.

Moreover, though not mentioned during the above-mentioned teleconference, Applicants have clearly described in the specification that applying acetic acid in-vivo is undesirable

because acetic acid causes “burns of the skin structures” and “compaction of chromatin within nuclei due to extraction of histone proteins” (see page 8, line 26 to page 9, line 4 of Applicants’ specification). Since claim 1 recites “applying a predetermined contrasting solution comprising an AlCl₃ solution to an in-vivo defect area”, any combination with acetic acid would be undesirable.

Other arguments presented in the teleconference include an improper “obvious to try” rationale (see MPEP 2145 X. B). Even if the Examiner intended to show that a replacement of acetic acid with AlCl₃ is obvious, the art lacks the motivation to make such a combination possible. The Examiner uses the Klaveness reference to show that particulate materials may be used as contrasting agents; however, particulate materials are a very broad and general area.

Case law has held that:

“the admonition that ‘obvious to try’ is not the standard under § 103 has been directed mainly at two kinds of error. In some cases, what would have been ‘obvious to try’ would have been to vary all the parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. ... In others, what was ‘obvious to try’ was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it.” (In re O’Farrell 853 F.2d 894, 903)

Neither Klaveness, Rajadhyaksha nor Richards-Kortum ever mention AlCl₃ in a contrasting solution. The only art cited by the Examiner that includes AlCl₃ are Yamamoto, which discloses various compounds including applying an aluminum chloride mixtures that may be applied to gums to stop the gums from bleeding (see Abstract of Yamamoto) and Prevender, which discloses using a composition that includes aluminum chloride as a hemostatic agent to control

gum bleeding (see Abstract and column 3, lines 50 to 55). Prevender and Yamamoto are related to stopping bleeding and unrelated to imaging tumors. Neither Prevender nor Yamamoto ever disclose or suggest that AICI in a contrasting solution. Therefore, none of the references cited specifically indicate that AICI would be successful in a contrasting solution. Thus, one of ordinary skill in the art would not have been motivated to combine these references.

For at least the foregoing reasons, Applicants request withdrawal of the art rejections.

Applicant submits that all dependent claims now depend on allowable independent claims.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.


Applicants submit that the entire application is now in condition for allowance. Such action is respectfully requested at the Examiner's earliest convenience.

All correspondence should be directed to the address below. Applicants' attorney can be reached by telephone at (781) 401-9988 ext. 23.

No fee is believed to be due for this Response; however, if any fees are due, please apply such fees to Deposit Account No. 50-0845 referencing Attorney Docket: MGH-036AUS.

Respectfully submitted,

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